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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,359

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John C. Evans

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ADAMS INTELLECTUAL PROPERTY LAW, P.A.

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EXAMINER

ORWIG, KEVIN S

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,359	Applicant(s) EVANS, JOHN C.	
	Examiner Kevin S. Orwig	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Foreword

Applicant's statements in the response dated Jan. 28, 2009 regarding the prior filing of various claim sets are acknowledged. To clarify the record, for the non-final Office action dated Oct. 30, 2008, the examiner examined the most recent claim set that was filed with the Office at the time of the examination. That claim set was filed Jul. 11, 2008 and stated, "The following list of claims will replace all previous versions and listings of claims" (see page 2 of the Jul. 11, 2008 filing).

DETAILED ACTION

The amendments and arguments filed Jan. 28, 2009 are acknowledged and have been fully considered. Claims 1-18 are amended (the text of claims 1 and 14 have been amended, and all other claims are amended via their dependency on either claim 1 or 14); claims 19 and 20 are withdrawn.

The rejection of claims 1-18 under 35 U.S.C. 103(a) is maintained as discussed below.

No new grounds of rejection are set forth below.

Claim Rejections - 35 USC § 112 (1st Paragraph)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The response filed Jan. 28, 2009 has introduced NEW MATTER into the claims. Amended claims 1 and 14 recite "...wherein the yarns in the warp direction are positioned such that each single elastic yarn is separated from other elastic yarns by at least one cotton yarn". Written description support is lacking for the full scope of this limitation because the specification does not disclose any embodiment wherein in the warp direction, *each single* elastic yarn is separated from other elastic yarns by at least one cotton yarn".

The response did not point out where support for amended claims 1 and 14 could be found in the originally filed disclosure. Although the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims, when filing an amendment an applicant should show support in the original disclosure for new or amended claims. See MPEP 714.02 and 2163.06 ("Applicant should therefore specifically point out the support for any amendments made to the disclosure."). Instant claims 1 and 14 now recite limitations, which were not clearly disclosed in the specification as filed, and now change the scope of the instant disclosure as filed. Such

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limitations recited in amended claims 1 and 14, which did not appear in the specification, as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C 112. Applicant is required to provide sufficient written support for the limitations recited in present claims 1 and 14 in the specification or claims, as-filed, or remove these limitations from the claims in response to this Office Action.

Claim Rejections - 35 USC § 103 (Maintained)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over ROBERTS (U.S. 6,267,744; Issued Jul. 31, 2001; Reference No. 1 on IDS dated Mar. 9, 2006) in view of MORE (U.S. Patent No. 5,092,318; Issued Mar. 3, 1992) as evidenced by (Informational Article: “Something holistic about elastic” Jul. 21, 2001, via the Internet Archive).

1. Roberts discloses elastic bandages having a substrate comprising warp and weft yarns (abstract; col. 1, lines 30-54). The substrate taught by Roberts comprises elastic and cotton yarns in a warp direction and Roberts teaches an embodiment wherein the warp elastic and inelastic yarns are arranged such that on each side of the elastic yarn is an inelastic yarn (element (b) of instant claim 1) (col. 1, lines 30-54, especially lines 41-43; col. 2, lines 7-8, 58-60, and 66 to col. 3, line 1). Roberts teaches that the weft yarns comprise cotton (element (c) of instant claim 1) (col. 3, lines 4-7). Furthermore, the bandages of Roberts *et al.* comprise an adhesive on the substrate material (element (d) of instant claim 1) (col. 1, lines 3-23; col. 1, lines 46-64).

2. Roberts does not teach knitted fabrics and do and are silent as to the presence of a lock-stitch on opposing edges of the substrate.

3. However, More discloses elastic bandages that are knitted and comprise a lock stitch at the edges of the fabric (abstract; col. 3, line 53-54; col. 4, lines 30-37).

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4. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to have produced the bandages of Roberts with knitted fabric since it is well known that knitted fabric has superior elastic properties relative to woven fabrics (see Internet Archive evidentiary reference). It would also have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to include a lock stitch at both edges of the bandage fabric since More teaches that it is advantageous to include a lock stitch at the edges of their bandages to prevent fraying and that a lock stitch is more comfortable and nonallergenic than other types of ravel prevention. In light of these teachings, one of ordinary skill in the art at the time the invention was made would have been motivated to produce the bandage fabric taught by Roberts as a knit fabric and to include a lock-stitch at the opposing edges to achieve a bandage with improved elastic properties and comfortability. Thus, the combined teachings of Roberts and More render claim 1 obvious.

5. Regarding claims 2, 6, and 7, Roberts is silent as to the total % weight of the cotton yarns in the fabric substrate and is silent as to the weight of the fabric substrate. However, the combination of Roberts and More teaches an elastic bandage that is substantially similar in form and substance to that instantly claimed. The MPEP states that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the applicant and

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the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP § 2112.01. Thus, in the absence of evidence to the contrary, it is the examiner’s position that the weight of the cotton yarns in the bandage taught by the combination of Roberts and More would be at least 97%, and the weight of the fabric substrate would be about 230 g/m², reading on claims 2, 6 and 7.

6. Roberts teaches the use of elastic yarns formed from polyurethane (i.e. these fibers may be 100% polyurethane) (col. 2, lines 39-41), reading on instant claim 8.

7. Regarding claims 9 and 10, Roberts teaches that the bandages of their invention have stretch characteristics that vary over a wide range (Figure 2). Since Roberts do not measure these characteristics in the same way as instantly claimed, it is not clear that these measurements are equivalent. However, it is noted that the claimed stretch and regain percentages are not limited in any other way. Thus, based on the teachings of Roberts (e.g. Figure 2), the bandages would have stretch of 85-95% at some point during the loading cycle test (e.g. see the right side of Figure 2). Further, it appears that the bandages would have a regain of 50-60% at some point as well (e.g. see the left side of Figure 2).

8. The combination of Roberts and More teaches an elastic bandage that is substantially similar in form and substance to that instantly claimed. The MPEP states that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been

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established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP § 2112.01. Thus, in the absence of evidence to the contrary, it is the examiner’s position that the bandages taught by the combination of Roberts and More would have a stretch of between 85-95%, and would also have a regain of 50-60% at least at some point during their use, reading on claims 9 and 10.

9. Roberts teaches that the adhesive comprises a pressure-sensitive adhesive (col. 1, lines 16-18; claim 11), reading on instant claim 11.

Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts in view of More as applied to claims 1, 2, 6, 7, and 8-11 above, and further in view of MORE (U.S. Patent No. 4,905,692; Issued Mar. 6, 1990) (hereinafter '692).

10. The combination of Roberts and More teaches the elastic bandage of instant claim 1 as applied above. Roberts and More are silent as to the ply of the yarns employed in their inventions. Thus, neither Roberts nor More teach the use of single or double ply yarns.

11. However, '692 discloses a fabric for medical applications comprising warp and weft yarns. '692 teaches the use of single ply warp yarns (col. 2, line 67 to col. 3, line 1). The MPEP states that the selection of known materials based on their suitability for their intended uses is *prima facie* obvious. See MPEP § 2144.07. Since the single ply

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yarns are used by '692 for the same purpose taught by Roberts and More (i.e. construction of an elastic bandage), it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use single ply yarns as taught by '692, in the bandages taught by Roberts, reading on instant claim 3.

12. Regarding claim 4, Roberts and More do not teach weft yarns of 600-800 Decitex.

13. However, '692 teaches the use of weft yarns which have a denier of 120-800 (i.e. a Decitex measure of about 133-889 (col. 2, line 62-63). The MPEP states that the selection of known materials based on their suitability for their intended uses is *prima facie* obvious. See MPEP § 2144.07. Since these yarns are used by '692 for the same purpose taught by Roberts and More (i.e. weft knitting for an elastic bandage), it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use single yarns of 600-800 Decitex as taught by '692, in the bandages taught by Roberts, reading on instant claim 4.

14. Regarding claim 5, More is silent as to the type of yarn used for the lock stitch.

15. However, '692 teaches that polyester fibers are useful for the synthetic fibers of their invention. The MPEP states that the selection of known materials based on their suitability for their intended uses is *prima facie* obvious. See MPEP § 2144.07. Since these yarns are used by '692 for the same purpose taught by Roberts and More (i.e. the construction of a lock-stitch containing elastic bandage), it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use polyester yarns for the lock stitch, in the bandages taught by Roberts, reading on claim 5.

Claims 1 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts in view of More as evidenced by (Informational Article: "Something holistic about elastic" Jul. 21, 2001, via the Internet Archive) as applied to claim 1 above, and in further view of CARTE (U.S. Patent No. 6,495,229; Issued Dec. 17, 2002).

16. The combination of Roberts and More teaches the elastic bandage of instant claim 1 as applied above. Regarding claim 12, neither Roberts nor More teach the use of a coadhesive.

17. Carte discloses adhesive bandages that comprise coadhesives (abstract; col. 5, lines 5-22). Since a common usage of adhesive-containing elastic bandages is to wrap them around an injured portion of the body to provide support for the injured member, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use a coadhesive per the teachings of Carte in the bandages of Roberts, to provide a bandage that would adhere more readily to itself (i.e. to the coadhesive) relative to the body part to which it was applied. Thus, the combined teachings of Roberts, More, and Carte read on claim 12.

18. Regarding claim 13, neither Roberts nor More teach discontinuous application of the adhesive.

19. Carte teaches that the application of rubber-based adhesives to bandages as a continuous layer is disadvantageous because it limits the ability of the skin to properly release water (col. 1, lines 24-50). Carte further teaches the discontinuous application of adhesives onto such articles as bandages (col. 3, lines 21-29). Thus, it would have

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been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to apply the adhesive in a discontinuous fashion per the teachings of Carte in the bandages of Roberts, to provide an adherent bandage that would still have the required breathability, reading on instant claim 13.

20. Regarding claim 14, the combination of Roberts and More renders obvious a knitted bandage with a lock stitch in opposing edges as applied above (element (a) of instant claim 14). Furthermore, Roberts discloses elastic bandages having a substrate comprising warp and weft yarns (abstract; col. 1, lines 30-54). The substrate taught by Roberts comprises elastic and cotton yarns in a warp direction and Roberts teaches an embodiment wherein the warp elastic and inelastic yarns are arranged such that on each side of the elastic yarn is an inelastic yarn (element (b) of instant claim 1) (col. 1, lines 30-54, especially lines 41-43; col. 2, lines 7-8, 58-60, and 66 to col. 3, line 1). (element (b) of instant claim 14). Roberts teaches that the weft yarns comprise cotton (element (c) of instant claim 14) (col. 3, lines 4-7). Furthermore, the Roberts teaches the application of an adhesive on one side the substrate material (col. 1, lines 3-23; col. 1, lines 46-49).

21. Neither Roberts nor More teach the use of a coadhesive.

22. Carte discloses adhesive bandages that comprise coadhesives (abstract; col. 5, lines 5-22). Since a common usage of adhesive-containing elastic bandages is to wrap them around an injured portion of the body to provide support for the injured member, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use a coadhesive per the teachings of Carte in the bandages of Roberts, to

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provide a bandage that would adhere more readily to itself (i.e. to the coadhesive) relative to the body part to which it was applied. Thus, the combined teachings of Roberts, More, and Carte read on claim 14.

23. Roberts teaches that the inelastic yarns (i.e. cotton yarns) will have a much larger cross-sectional area than the elasticized yarns (col. 1, lines 65-66), reading on instant claim 15.

24. Roberts teaches that the fabric substrate includes an elastic yarn with an inelastic (i.e. cotton) yarn on each side of the elastic yarn (col. 1, lines 41-43), reading on instant claim 16.

25. Roberts teaches that the warp yarns are arranged such that pairs of twisted inelastic (i.e. cotton) yarns on each side of the elastic yarns have the same twist, the pairs on opposite sides of the inelastic yarns therefore having opposite twist directions (col. 1, lines 50-54), reading on instant claim 17.

26. Regarding claim 18, Roberts are silent as to the method of applying the adhesive. Carte teaches that the discontinuous adhesive pattern may be applied by any means known to those in the art, such as blowing the adhesive onto the fabric substrate (col. 4, lines 51-54). Since Roberts is silent as to the application method for the adhesive, the ordinary artisan would have turned to the literature for guidance in this matter. Thus, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use the known technique of blowing the adhesive onto the fabric substrate per the teachings of Carte to produce the bandages of Roberts, in order

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to provide a bandage that would be both adherent and breathable. Thus, the combined teachings of Roberts, More, and Carte read on claim 18.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, in the absence of evidence to the contrary, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

Response to Arguments

Applicant argues that the references do not teach the limitations as currently presented on in the amended claims filed Jan. 28, 2009. The discussion presented *supra* details how the references render the instant claims obvious. As set forth in the rejections above, the references of record teach and/or suggest all of the instantly claimed limitations.

Summary/Conclusion

Claims 1-18 stand rejected.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Orwig whose telephone number is (571)270-5869. The examiner can normally be reached Monday-Friday 7:00 am-4:00 pm (with alternate Fridays off). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached Monday-Friday 8:00 am-5:00 pm at (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KSO

/David J Blanchard/
Primary Examiner, Art Unit 1643